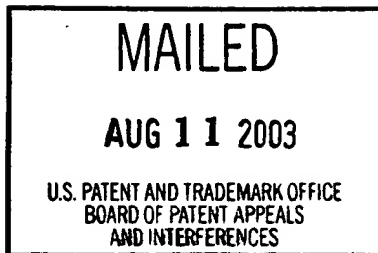


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte CHRISTOPH ESPEY

Appeal No. 2003-0721
Application No. 09/529,365

HEARD: JULY 16, 2003

Before ABRAMS, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8, 9, 15, 16 and 22. Claims 10-14 and 17-21, the only other claims pending in this application, stand withdrawn from consideration as being directed to a nonelected species.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to an electrically activated fuel injection valve. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art reference of record in rejecting the appealed claims:

Gordon et al. (Gordon)	5,405,088	Apr. 11, 1995
------------------------	-----------	---------------

The following rejection is before us for review.

Claims 8, 9, 15, 16 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gordon.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection and answer (Paper Nos. 13 and 20) for the examiner's complete reasoning in support of the rejection and to the brief (Paper No. 19) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the Gordon reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the rejection of claims 8¹, 9 and 22 as being anticipated by Gordon. As pointed out by appellant on page 6 of the brief, Gordon's valve is activated by fuel conveyed under pressure through a supply conduit 47 into a collection chamber 36 and then into a pressure chamber 21. As explained in the third paragraph of column 3 of Gordon, the buildup of pressure acts on the piston valve 20 of the closing head 16, such that, when a specific opening pressure is reached at which the prestress of closing spring 40 and the force on the needle valve resulting from the gas pressure in the combustion chamber of the combustion engine is overcome, the needle valve 15 is displaced in the direction of flow. Thus, Gordon's valve is clearly not an "electrically activated" valve, as called for in claims 8, 9 and 22.

The examiner's position that the adjectival recitation "electrically activated" is considered to be "suggestive or optional, but not limitative" (see page 5 of the answer) is not well taken. The fact that the body of claims 8 and 22 broadly recites an "activating device" rather than an electrical activating device does not alter the fact that the claims recite an electrically activated valve.

¹ The recitation in the last paragraph of claim 8 of "said annular space providing a contact area between the valve member and the valve seat" does not appear to be consistent with appellant's specification, which identifies an "annular space" 11 and a "contact area" 14. As illustrated in Figures 2-7, the contact area 14 appears to be located radially outside of the annular space 11.

For the foregoing reason, we conclude that claims 8, 9 and 22 are not anticipated² by Gordon. It thus follows that we must reverse the examiner's rejection of these claims.

We turn next to the examiner's rejection of claims 15 and 16 as being anticipated by Gordon. Claim 15 reads on Gordon's valve as follows: a valve member (closing head 16 and ring 19 with frustoconical valve cone 17) having a valve stem (shaft 14), a valve housing (nozzle body 10 and nozzle holder 12) containing the valve stem and a valve seat 18, a valve spring (closing spring 40) which acts in a direction to close the valve, an activation device (supply fuel pressure) which acts to open the valve (see the third paragraph of column 3), and a valve guide (guide bore 35 and guide segment 23), with a contact area formed between the valve cone 17 and the valve seat 18 being bounded by a step (the uppermost sharp corner of valve cone 17 as referenced on the marked up copy of Figure 2 of Gordon provided by the examiner and attached to the final rejection) which is adjoined by a guide surface (the downward and outward sloping surface immediately outside the step, also referenced in the marked up copy of Figure

² Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

2 attached to the final rejection). The guide surface is located radially further from the valve stem than the step.

While we have considered all of appellant's arguments as presented in the brief, in light of the above, it should be apparent that we do not find these arguments persuasive. As to appellant's argument that the "valve guide is specifically claimed as having a purpose of guiding the valve stem 8 in the valve housing 2" (brief, page 5), the guide bore 35 and guide segment 23 would certainly appear to guide the shaft 14 in the valve housing.

For the foregoing reasons, we shall sustain the examiner's rejection of claim 15 as being anticipated by Gordon. Inasmuch as appellant has not argued separately the patentability of claim 16 apart from claim 15, claim 16 falls with claim 15 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)). The rejection of claim 16 is thus also sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 8, 9, 15, 16 and 22 under 35 U.S.C. § 102 is affirmed as to claims 15 and 16 and reversed as to claims 8, 9 and 22.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

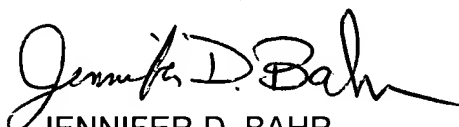
AFFIRMED-IN-PART



NEAL E. ABRAMS
Administrative Patent Judge



LAWRENCE J. STAAB
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

Appeal No. 2003-0721
Application No. 09/529,365

Page 7

CROWELL & MORING, LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 2004-4300